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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,641	03/16/2004	Haruo Akiba	250385US3	1150
22850	7590	02/02/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				KASZTEJNA, MATTHEW JOHN
ART UNIT		PAPER NUMBER		
3739				
NOTIFICATION DATE			DELIVERY MODE	
02/02/2009			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/800,641	AKIBA, HARUO	
	<b>Examiner</b>	<b>Art Unit</b>	
	MATTHEW J. KASZTEJNA	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 December 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2 and 4-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2 and 4-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on December 4, 2008, amended claim 1 is acknowledged. The following new and reiterated grounds of rejection are set forth:

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Line 19 of claim 1 refers to a “second conduit”, rather then a “second fluid conduit”. Applicant is advised to stay consistent with all terminology through the entire claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear what is meant by the limitation “the second conduit being inclined with respect to a longitudinal axis of the universal cable”. The second fluid conduit is recited as being “provided internally of the universal cable” (line 10 of claim). If the conduit is provided within the universal cable, then the two components would be arranged in a coaxial fashion and thus share a common longitudinal axis. Figure 2 shows the second fluid conduit 5 and second connection port 14 as being inclined with respect to the longitudinal axis of fluid feed adaptor 20,

mouthpiece 10 and fluid supply passage 23. These components (as well as the first fluid conduit 4 and connector 13) all share a common longitudinal axis to which the second fluid conduit 5 and connector 14 are inclined with respect to. Thus, the claim stand rejected under 35 U.S.C. 112, second paragraph, as it is unclear how the second fluid conduit can be inclined with respect to a longitudinal axis of the universal cable *and* also provided internally of the universal cable. For purposes of examination, the claim is examined as though the second fluid conduit is inclined with respect to the longitudinal axis of the fluid feed adaptor.

Claims 5 and 7 contain the trademark/trade name Luer-Lok. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the connection between the mouth piece and the fluid supply adaptor and, accordingly, the identification/description is indefinite.

The remaining claims are necessarily rejected as being dependent upon a rejected base claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,871,441 to Ishiguro et al.

**In regard to claim 1**, Ishiguro et al. discloses an endoscopic fluid supply conduit system suitable for use in an endoscope which comprises: a manipulating head assembly 5; an insertion tube 4 and a universal cable 6 connected at a fore end of the manipulating head assembly (see Fig. 2), the universal cable being connected to and extending downwardly from the manipulating head assembly (see Fig. 3), a first fluid conduit 83 (also referred to as 29 in Fig. 3) extended from the manipulating head assembly and through the insertion tube toward an injection port 34 provided on a rigid tip end section at a fore distal end of the insertion tube (see Col. 4, Lines 46-47); a second fluid conduit 82 (also referred to as 31 in Fig. 3) provided internally of the universal cable and communicable with the first fluid conduit within the manipulating head assembly (see Col 4, Lines 50-58); a fluid feed port 87 formed at the proximal side of the manipulating head assembly (see Col. 8, Lines 40-42) and a mouth piece 81 fixedly fitted in the fluid feed port (see Fig. 1 and Col. 8, Lines 42-49), the fluid feed port having an axial receptacle bore 59, 61 (see Fig. 1 and Col. 6, Lines 42-48), a first connection port 94 formed at an inner axial end of the mouth piece for connecting the

first fluid conduit 83 in communication with the receptacle bore 61 and a second connection port 93/101 provided at one side of the mouth piece 81 for connecting the second fluid conduit 82 in communication with the receptacle bore 61 (see Fig. 1 and Col. 8, Lines 55-60); the first fluid conduit being extended linearly from the axial receptacle bore toward the insertion tube, and the second conduit being inclined with respect to a longitudinal axis of the universal cable (see Figs. 1 and 21-23); a fluid supply adaptor 51 having an axially extended fluid supply passage 59, a tip end 64 thereof being opened toward the first connection port and being adapted to be inserted into the mouth piece to block a fluid flow (via wall member 138) from the second fluid conduit to the first fluid conduit and to feed a fluid from the fluid supply passage to the first fluid conduit 83 (see Fig. 21 and Col. 10, Lines 40-50); and a plug member 40, 51 fitted in an outer open end of the receptacle bore of the mouth piece in place of the fluid supply adapter to bring the second connection port 101 into communication with the first connection port through the receptacle bore (see Fig. 23 and Col. 11, Lines 23-35).

**In regard to claim 2,** Ishiguro et al. discloses an endoscopic fluid supply conduit system, wherein the fluid feed port 87 on the manipulating head assembly 5 is provided on a side away from the side to which the insertion tube is connected (see Figs. 2-3). The fluid feed port is provided within the channel switching device 1, which as seen in figure 2 is located on a side away from the side to which the insertion tube 3 is connected.

**In regard to claim 4,** Ishiguro et al. discloses an endoscopic fluid supply conduit system, wherein the mouth piece 81 is arranged in such a way as to disconnectibly

receive the fluid supply adaptor 51 in the receptacle bore, and is communicated with the first fluid conduit 83 at an inner axial end 94 and with the second fluid conduit 82 at a halfway position in the axial direction (see Col. 10, Lines 40-51). The cap 40 is used to move piston 51 upward and downward, thus the mouthpiece 81 receives the fluid supply adaptor (i.e. piston 51) in a “disconnectibly” manner. Furthermore, the second communication port 101 is located at a halfway position in the axial direction as seen in Figs 21-23.

**In regard to claim 8**, Ishiguro et al. discloses an endoscopic fluid supply conduit system, further comprising a lid member 40 detachably attachable to the fluid supply adaptor 51 to close an outer open end of the latter (see Fig. 1 and Col. 5, Lines 44-48).

#### ***Allowable Subject Matter***

Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments filed December 4, 2008 have been fully considered but they are not persuasive.

Applicant states that Ishiguro et al. fail to disclose a fluid supply adaptor having an axially extending fluid supply passage, a tip end thereof being opened towards a first connection port. Examiner disagrees. Ishiguro et al. clearly shows a fluid supply adaptor 51 having an axially extended fluid supply passage 59, a tip end 64 thereof being opened *toward* the first connection port and being adapted to be inserted into the

mouth piece to block a fluid flow (via wall member 138) from the second fluid conduit to the first fluid conduit and to feed a fluid from the fluid supply passage to the first fluid conduit 83 (see Fig. 21 and Col. 10, Lines 40-50). Figure 23 clearly shows a tip end 64 of the fluid supply adaptor 51 being opened toward the first connection port 94. The channel 59 comprises the area within walls 138 and axially extends therethrough, thus meeting the claims, as broadly as claimed.

Furthermore, it is noted that the words “for” and “adapted to” in the claim may be properly interpreted as “capable of,” and “capable of” does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./  
Examiner, Art Unit 3739

/Linda C Dvorak/  
Supervisory Patent Examiner, Art  
Unit 3739